



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2022-0001]

Expanded Collaborative Search Pilot Program—New Combined Petition Option For Participation

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO), in partnership with the Japan Patent Office (JPO) and the Korean Intellectual Property Office (KIPO), have collaborated on a new petition option for participation in the Expanded Collaborative Search Pilot (CSP) program. The new petition option, which has several enhancements compared to the current petition form and process, permits an applicant to file a combined petition in one of the partner intellectual property (IP) offices rather than separate petitions in both partner IP offices. Enhancements include a more user-friendly layout, addition of multilingual text, and a foundation for data collection that both satisfies the petition requirements and streamlines the process for partaking in the Expanded CSP program.

DATES: The combined petition option and the related process will take effect on [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER]. Each IP office will continue to grant no more than 400 requests per year per partner office for the duration of the pilot, which is currently set to expire on October 31, 2022.

FOR FURTHER INFORMATION CONTACT: Inquiries regarding any specific application participating in the pilot may be directed to Jessica Patterson, Senior Advisor and Director, International Worksharing, Planning, and Implementation; Office of International Patent Cooperation; at 571-272-8828 or Jessica.Patterson@uspto.gov. Any inquiry regarding this pilot program and the petition process can be emailed to csp@uspto.gov. Inquiries concerning this notice may be directed to Michael Arguello; Management and Program Analyst; International Worksharing, Planning, and Implementation; Office of International Patent Cooperation; at 571-270-7876 or Michael.Arguello@uspto.gov.

SUPPLEMENTARY INFORMATION:

I. Background

The USPTO continually looks for ways to improve its worksharing pilot programs, including the Expanded CSP program. The Expanded CSP program provides applicants who cross-file with the USPTO and the JPO or the KIPO with search results from each office early in the examination process. It is designed to accelerate examination and provide the applicant with more comprehensive prior art by combining the search expertise of the USPTO and the JPO or the KIPO examiners before issuing a first office action. For additional details of this program, *see* Expanded Collaborative Search Pilot Program Extension, 86 FR 8183 (February 4, 2021) (Expanded CSP extension notice). Feedback from applicants based in the United States, Korea, and Japan has cited the petition process as an area for improvement, specifically the requirement to petition each office separately. As a result, the USPTO collaborated with its partner IP offices, the JPO and the KIPO, to develop combined petition forms (PTO/437-JP for the USPTO/JPO

pilot program and PTO/437-KR for the USPTO/KIPO pilot program). Submitting a completed combined petition form to either the USPTO or the partner IP office (JPO or KIPO) will result in receipt of the form at both offices in the corresponding pilot and placement in the application files of both counterpart applications.

The current petition option and process, in which an applicant files a petition or a request separately with each partner IP office (original petition option), remains available. Under the original petition option, an applicant must submit petition form PTO/SB/437 to the USPTO to request CSP participation for the U.S. application and a separate submission to the partner IP office in the desired pilot to request CSP participation for a counterpart application.

II. Overview of the Combined Petition Option

Applicants need only submit one combined petition form to the USPTO or the partner IP office (JPO or KIPO). There are separate agreements between the USPTO and the JPO and the USPTO and the KIPO. Therefore, to request participation in the corresponding pilot between the USPTO and the JPO using this combined petition option, applicants must file the combined petition form PTO/437-JP with either the USPTO or the JPO. Likewise, to request participation in the corresponding pilot between the USPTO and the KIPO using this combined petition option, applicants must file the combined petition form PTO/437-KR with either the USPTO or the KIPO. However, if an application in a pilot program corresponds to more than one counterpart application in a partner IP office, the combined petition option cannot be used. In this situation, an applicant must use the original petition option to request participation in the Expanded CSP program.

Under the combined petition option, use of the proper combined petition form will assist applicants in complying with the pilot program's requirements, and will assist the USPTO in quickly identifying participating applications and the partner IP office. The combined petition forms for the USPTO/JPO pilot and the USPTO/KIPO pilot are multilingual. Both combined petition forms provide links to the requirements (with exceptions noted in section VI below) and conditions for entry into the respective pilot program for each partner IP office. As each office's conditions for entry may differ, applicants should review the requirements of the relevant partner IP offices to ensure compliance.

Forms PTO/437-JP and PTO/437-KR are available at www.uspto.gov/CollaborativeSearch. The forms will also be available as Portable Document Format (PDF) fillable forms in EFS-Web and Patent Center and on the USPTO website at www.uspto.gov/patents/apply/forms/forms-patent-applications-filed-or-after-september-16-2012. The Office of Management and Budget (OMB) has reviewed and approved the collection of information involved in this pilot program, under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.), as part of a collection identified by OMB control number 0651-0079. Collection 0651-0079 is available at OMB's Information Collection Review website, www.reginfo.gov/public/do/PRAMain. No fee for the combined petition to make special under 37 CFR 1.102 is required for participation in the Expanded CSP program.

III. Filing a Combined Petition Form

If opting to use a combined petition form, applicants must file a completed combined petition form (PTO/437-JP or PTO/437-KR) for each pilot the applicant wishes to utilize.

Combined petition form PTO/437-JP must either be directly filed in the U.S. application or directly with the JPO for the USPTO/JPO pilot program, and combined petition form PTO/437-KR must either be directly filed in the U.S. application or directly with the KIPO for the USPTO/KIPO pilot program. If the combined petition form is directly filed in the U.S. application, the applicant must file it using either EFS-Web or Patent Center. If the applicant directly files the combined petition form with the partner IP office, the combined petition form must be accompanied by supporting documents (e.g., an English translation of the claims from the counterpart application; a machine translation of the claims is acceptable). The corresponding partner IP office will then transmit the combined petition form and supporting documents to the USPTO. The applicant should not file the combined petition form directly with both the USPTO and the corresponding partner IP office.

Based on the agreements between the USPTO and the partner IP offices, if the applicant directly files the combined petition form with the USPTO, then the USPTO must transmit the completed form and any accompanying supporting documents, along with the date of receipt, to the corresponding partner IP office. Additionally, if the applicant files the combined petition form directly with the JPO or the KIPO, then the office that received the filing must transmit the form and the accompanying supporting documents, along with its date of receipt, to the USPTO. The USPTO will place the combined petition form and the accompanying supporting documents in the file of the U.S. application.

Incomplete combined petition forms will not be forwarded to the corresponding partner IP office and will be dismissed in accordance with the respective Memorandums of Cooperation between partner IP offices.

Under the combined petition option, the IP partner offices have agreed to transmit the combined petition form to the corresponding partner IP office within 15 days of receipt from the applicant. This reduces the risk of the counterpart application being acted upon by an examiner in the partner IP office before that application enters the pilot program, which would result in both applications being denied entry into the Expanded CSP program. The request for participation in the Expanded CSP program must be granted by both the IP office in which the request is directly filed and the partner IP office for both applications prior to any examination in either office.

To the extent that the combined petition form forwarded to the USPTO from the partner IP office does not comply with the requirements of 37 CFR 1.4(d)(2) and (d)(3), and 1.6(a), these requirements are waived for certain elements. Specifically, with respect to 37 CFR 1.4(d)(2), a forwarded combined petition form containing an S-signature will not be required to be filed by facsimile transmission, via the USPTO's electronic filing system (i.e., EFS-Web or Patent Center), or on paper. With respect to 37 CFR 1.4(d)(3), a forwarded combined petition form containing a graphic representation of a handwritten signature or an S-signature will not be required to be filed via the USPTO's electronic filing system. With respect to 37 CFR 1.6(a), a forwarded combined petition form will be accorded a receipt date even though it was not received at the USPTO by mail, filed via the USPTO's electronic filing system, or hand-delivered to the USPTO. The U.S. receipt date of the combined petition form will either be the actual date that the combined petition form is received at the USPTO via the USPTO's electronic filing system or the date the combined petition form is transmitted to the USPTO from the partner IP office, which may not be the same as the receipt date in the partner IP office.

IV. Requirements for Participation in the Expanded CSP

To be accepted into the Expanded CSP program, applicants who use the combined petition option must meet all the requirements of the program that are set forth in section III of the Expanded CSP extension notice, except with the following modifications.

Under the combined petition option, the combined petition form PTO/437-JP or PTO/437-KR must be used instead of form PTO/SB/437, and the combined petition form, as discussed above, must be submitted to either the USPTO or the partner IP office (the JPO or the KIPO). Separate petitions are not required to be filed in both the USPTO and the partner IP office. The combined petition form PTO/437-JP or PTO/437-KR also includes an express written consent under 35 U.S.C. 122(c) for the USPTO to receive the combined petition form (if filed directly with the corresponding partner IP office) and to accept and consider prior art references and comments from the designated partner IP office during the examination of the U.S. application. The combined petition form also includes written authorization for the USPTO to forward the form (if filed directly with the USPTO) to the corresponding partner IP office and to provide to the designated IP partner office, before a first office action on the merits, access to the participating U.S. application's bibliographic data and search results, in accordance with 35 U.S.C. 122(a) and 37 CFR 1.14(c). No other consents are required.

V. Treatment of a Combined Petition Form

The combined petition form filed directly or indirectly in the U.S. application will be treated in the manner set forth in section IV of the Expanded CSP extension notice.

VI. Requirement for Restriction

The requirement for restriction set forth in section V of the Expanded CSP extension notice remains the same for the combined petition option.

VII. First Action on the Merits

Under the Expanded CSP program, the USPTO examiner will consider all exchanged search results. However, search results that are not received by the USPTO within four months from the date the USPTO granted the petition may not be included in the first action on the merits (FAOM). The examiner will prepare and issue an Office action and notify the applicant if any designated partner IP office did not provide search results prior to the issuance of the Office action. Once an FAOM issues, the application will no longer be treated as special under the Expanded CSP program.

The USPTO will continue to cooperate with applicants, IP stakeholders, and partner IP offices to improve the CSP process. More information on the CSP is available at www.uspto.gov/CollaborativeSearch.

Andrew Hirshfeld,
Commissioner for Patents, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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